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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,460	10/10/2001	Andrew Ernest Fano	10022/187	4729

28164 7590 06/23/2006
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EXAMINER

DIXON, THOMAS A

ART UNIT

PAPER NUMBER

3639

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,460

Applicant(s)

FANO, ANDREW ERNEST

Examiner

Thomas A. Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 3-27-06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The allowability indicated in the previous action is withdrawn in view of, applied below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 28 and 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the apparatus contains a computer program on a computer readable medium, but the program is seen to be code-per se as it is not explicitly executable, the phrase "a computer executable program" would remedy the problem.

Double Patenting

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 20, 36, 42 and 67 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,317,718. Although the conflicting claims are not identical, they are not patentably distinct from each other because the feature of claims 27, 41, 48, 69 which depend from claims 20, 36, 42, and 67 are obviously of the same scope.

3. Claims 28, 49 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,317,718. Although the conflicting claims are not identical, they are not patentably distinct from each other because the feature of claims 35, 55 which depend from claims 28 and 49 are obviously of the same scope.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 20-26, 28-34, 36, 37-40, 42-47, 49-54, 56-59, 61-65, 67-68, 70-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouve et al (5,682,525) in view of Stewart (5,835,061).

As per Claims 20, 28.

Bouve et al ('525) discloses:

obtaining information identifying an item of merchandise from a user, see page column 2, lines 26-31;

determining a physical location of a user, see column 2, lines 46-52;

querying a computerized network of information utilizing a query based on the information identifying the item of merchandise and the physical location of the user, see column 2, lines 26-28, column 3, line 45, column 11, lines 15-19 and lines 24-29;

receiving from a retailer-based agent in response to the query information associated with the item of merchandise from the retailer proximate to the user being associated with the item of merchandise that the user desires to purchase, see column 11, lines 8-14 figures 2 (32, 34) and 4 (73, user may print a list of information about these items or select one by clicking" in which "computer products" are the items of interest, see column 5, lines 4-13.

displaying the information and a physical location of the retailer, see column 11, lines 8-14.

Bouve et al ('525) does not disclose a customized offer.

Stewart ('061) teaches a customized offer based on customer's location and previous shopping history, see column 6, line 50 - column 7, line 5 and column 8, lines 12-18, for the benefit of customer convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the customized offer taught by Stewart ('061) in the invention of Bouve et al ('525) for the benefit of customer convenience.

As per Claim 21, 29, 43, 50, 62, 65

Bouve et al ('525) further discloses a list, see column 2, lines 13-16.

As per Claim 22, 30, 44, 51.

Bouve et al ('525) further discloses a query based on the list and user's location, see column 2, lines 13-16 and column 11, lines 3-14.

As per claim 23, 31, 45, 52.

Bouve et al ('525) further discloses the list is generated by the user at a location remote from the retailer, see column 6, lines 39-67.

As per Claim 24, 32, 38, 46, 53, 58.

Bouve et al ('525) further discloses displaying a list of items, see figure 4 (73) and column 11, lines 8-14.

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Bouve et al ('525) does not specifically disclose displaying the prices associated therewith.

Stewart ('061) teaches displaying prices associated with items, see column 6, line 31 – column 7, line 6, for the benefit of customer convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the item prices as taught by Stewart ('061) in the invention of Bouve et al ('525) for the benefit of customer convenience.

As per Claim 26, 47

Bouve et al ('525) further discloses the internet, see column 11, lines 24-30.

As per Claim 34, 54

Bouve et al ('525) further discloses pattern recognition to enhance the location of pertinent information, see column 8, lines 63-67.

As per Claim 36, 61, 63, 64, 67, 68.

Bouve et al ('525) discloses:

obtaining information identifying an item of merchandise from a user, see page column 2, lines 26-31;

determining a physical location of a user, see column 2, lines 46-52;

querying a computerized network of information utilizing a query based on the information identifying the item of merchandise and the physical location of the user, see column 2, lines 26-28, column 3, line 45, column 11, lines 15-19 and lines 24-29;

receiving information from an agent in response to the query information about an item, the item of merchandise being associated with the item the customized offer for sale of the item of merchandise from the retailer proximate to the user being associated with the item of merchandise that the user desires to purchase, see column 11, lines 8-14 figures 2 (32, 34) and 4 (73, user may print a list of information about these items or select one by clicking" in which "computer products" are the items of interest, see column 5, lines 4-13.

displaying the purchasing information.

Bouve et al ('525) does not disclose a customized offer.

Stewart ('061) teaches a customized offer based on customer's location and previous shopping history, see column 6, line 50 - column 7, line 5 and column 8, lines 12-18, for the benefit of customer convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the customized offer taught by Stewart ('061) in the invention of Bouve et al ('525) for the benefit of customer convenience.

As per Claim 25, 33, 39, 59.

Bouve et al ('525) does not disclose suggesting items for sale.

Stewart ('061) teaches a customized offer based on customer's preprogrammed criteria, see column 6, line 50 - column 7, line 5 and column 8, lines 12-18, for the benefit of customer convenience.

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Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to suggest items for sale as taught by Stewart ('061) in the invention of Bouve et al ('525) for the benefit of customer convenience.

As per Claim 37, 57.

Bouve et al ('525) does not specifically disclose parsing the terms based on predefined criteria to create the query.

Stewart ('061) teaches a parsing and filtering engine for the benefit of analyzing each alert and determining if it meets the recipient's criteria.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to parse the input for the benefit of analyzing each alert and determining if it meets the recipient's criteria.

As per Claim 40.

Bouve et al ('525) does not disclose recognizing patterns to suggest items for sale.

Stewart ('061) teaches a customized offer based on customer's preprogrammed criteria, see column 6, line 50 - column 7, line 5 and column 8, lines 12-18, for the benefit of customer convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the customized offer as taught by Stewart ('061) in the invention of Bouve et al ('525) for the benefit of customer convenience.

As per Claims 42, 48.

Bouve et al ('525) discloses:

obtaining information identifying an item of merchandise from a user, see page column 2, lines 26-31;

determining a physical location of a user, see column 2, lines 46-52;

querying a computerized network of information utilizing a query based on the information identifying the item of merchandise and the physical location of the user, see column 2, lines 26-28, column 3, line 45, column 11, lines 15-19 and lines 24-29;

receiving from a retailer-based agent in response to the query information associated with the item of merchandise from the retailer proximate to the user being associated with the item of merchandise that the user desires to purchase, see column 11, lines 8-14 figures 2 (32, 34) and 4 (73, user may print a list of information about these items or select one by clicking" in which "computer products" are the items of interest, see column 5, lines 4-13.

displaying the information and a physical location of the retailer, see column 11, lines 8-14.

Bouve et al ('525) does not disclose a customized offer or suggesting items.

Stewart ('061) teaches a customized offer and suggesting items based on customer's preprogrammed criteria, see column 6, line 50 - column 7, line 5 and column 8, lines 12-18, for the benefit of customer convenience.

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Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the customized offer taught by Stewart ('061) in the invention of Bouve et al ('525) for the benefit of customer convenience.

As per Claim 56.

Bouve et al ('525) discloses:

obtaining information identifying an item of merchandise from a user, see page column 2, lines 26-31;

determining a physical location of a user, see column 2, lines 46-52;

querying a computerized network of information utilizing a query based on the information identifying the item of merchandise and the physical location of the user, see column 2, lines 26-28, column 3, line 45, column 11, lines 15-19 and lines 24-29;

receiving information from an agent in response to the query information about an item, the item of merchandise being associated with the item the customized offer for sale of the item of merchandise from the retailer proximate to the user being associated with the item of merchandise that the user desires to purchase, see column 11, lines 8-14 figures 2 (32, 34) and 4 (73, user may print a list of information about these items or select one by clicking" in which "computer products" are the items of interest, see column 5, lines 4-13.

displaying the purchasing information.

Bouve et al ('525) does not disclose a customized offer or suggesting items for sale.

Stewart ('061) teaches a customized offer based on customer's preprogrammed criteria, see column 6, line 50 - column 7, line 5 and column 8, lines 12-18, for the benefit of customer convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the customized offer taught by Stewart ('061) in the invention of Bouve et al ('525) for the benefit of customer convenience.

As per Claim 70.

Bouve et al ('525) discloses:

a retailer agent configured to provide a computerized network of information related to items of merchandise from a plurality of retailers and to determine a physical location of a mobile shopper, see column 2, lines 10-52;

a shopping agent communicatively coupled with the retailer agent and configured to store information related to desired items of merchandise, see column 1, line 60 - column 2, line 9.

Bouve et al ('525) does not disclose an offer of items for sale.

Stewart ('061) teaches a customized offer based on customer's preprogrammed criteria, see column 6, line 50 - column 7, line 5 and column 8, lines 12-18, for the benefit of customer convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the customized offer taught by Stewart ('061) in the invention of Bouve et al ('525) for the benefit of customer convenience.

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As per Claim 71.

Bouve et al ('525) further disclose the display of the location of the retailer proximate the shopper with respect to the location of the shopper, see column 2, lines 46-52.

5. Claims 27, 35, 41, 48, 55, 66, 69, 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouve et al (5,682,525) in view of Stewart (5,835,061) further in view of Bianco (5,047,416).

As per Claim 27, 35, 41, 48, 55, 66, 69, 72.

Bouve et al ('525) does not specifically disclose alerting the user to the best price.

Bianco ('416) teaches alerting the users to better values, see column 4, lines 1-8, for the benefit of increased customer service.

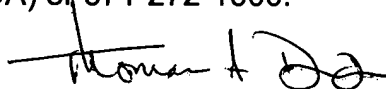
Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to alert the customers of Bouve et al ('525) of the best price or better values as taught by Bianco ('416) for the benefit of increased customer service.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (571) 272-6803. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Thomas A. Dixon
Primary Examiner
Art Unit 3639

June 06